In the Supreme Court of the United States

OCTOBER TERM, 1961

No. 857

CHARLES J. HIRSCH, PETITIONER

v.

DAVID L. LADD, COMMISSIONER OF PATENTS

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the Court of Customs and Patent Appeals (Pet. App. 1a-12a) is reported at 295 F. 2d 251.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on October 25, 1961 (Pet. App. 1a). A timely petition for rehearing was denied on January 12, 1962. The petition for a writ of certiorari was filed on April 10, 1962. The petitioner

attempts to invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review a judgment of the United States Court of Customs and Patent Appeals which affirmed the denial of certain patent claims by the Board of Appeals of the United States Patent Office.

2. Whether petitioner made adequate disclosure of the construction of a generator which was essential to the operation of his invention.

STATUTE INVOLVED

The Act of July 19, 1952, C. 950, Section 1, 66 Stat. 798, 35 U.S.C. 112, provides in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. * * *

STATEMENT

Petitioner, in 1954, applied to the Patent Office for a patent on a certain combination of engineering tools designed to overcome a picture tube problem in color television (Pet. 1a). An essential element of the combination was a saw-tooth generator which, it was

stated, was to operate at a frequency higher than 2 megacycles (Pet. 1a-2a). The Examiner rejected the application on the ground that there had been inadequate disclosure of the method of construction of the saw-tooth generator. The basis of the rejection was that such generators, operable at 2 megacycles, were not known in the prior art and petitioner had not shown how this generator was to operate at that frequency (Pet. 2a-3a). The Examiner's decision was upheld by the Board of Appeals of the Patent Office, and petitioner then appealed to the United States Court of Customs and Patent Appeals (Pet. 1a).

The Court of Customs and Patent Appeals agreed with the Patent Office's conclusion that there had been insufficient disclosure of the saw-tooth generator. It held (Pet. 6a) that "[i]t was the examiner's duty to compel a disclosure which would enable those skilled in the art to practice the invention without having to design circuitry not shown to be readily available in the art." It further held (Pet. 5a) that such disclosure had not been made where, as here, petitioner "could not cite any reference in the literature establishing the 'conventional' construction of his 2 mc. saw-tooth signal generator, as he asserted it to be," nor describe it to the examiner.

ARGUMENT

As we have previously noted,[1] it is very doubtful whether decisions of the Court of Customs and Patent Appeals, in patent cases on appeal from the Patent Office, are now reviewable on certiorari by this Court. In any event, there would be no occasion for review in this case. The sole issue presented is the factual question whether petitioner made a sufficient disclosure in his patent application. The decision of the court below that his disclosure was inadequate was plainly correct, and there is no conflict with any prior decisions.

1. In *Postum Cereal Co.* v. *Calif. Fig Nut Co.*, 272 U.S. 693, this Court held that it lacked jurisdiction to review decisions of the Court of Appeals of the District of Columbia on appeal from determinations of the Patent Officet in patent and trademark applications. It was said that the decision in an appeal from the Patent Office was not a judicial judgment but was "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. 698-699. The jurisdiction of the Court of Appeals of the District of Columbia over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1-4, 45 Stat. 1475. But the

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[1] Brief in Opposition, *Larsen* v. *Ladd*, No. 671, this Term, pp. 5-6; and Brief in Opposition, *Commissariat a' L'Energie Atomique* v. *Watson*, No. 826, October Term, 1959, pp. 6-9, certiorari denied, 362 U.S. 977.

basic character of the proceeding was not changed, and thereafter, in denying certiorari to review decisions of the latter court in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction," citing *Postum Cereal*. In subsequent patent cases, the Court has merely denied certiorari, without more.

We believe that, despite some of the language in the *Postum Cereal* opinion, there are no constitutional obstacles to review by this Court of the patent rulings of the court below (see the Brief for the United States in *Lurk* v. *United States*, No. 481, this Term, pp. 104, *et seq.*). At the same time there is the grave doubt whether the Congress has vested this Court with that jurisdiction. In the present proceeding, the petitioner invokes 28 U.S.C. 1256 to sustain the Court's jurisdiction (Pet. 2). Section 1256 is part of the Act of June 25, 1948, 62 Stat. 683, codifying Title 28 of the United States Code. Prior to that codification, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was a provision relating to customs cases. That provision, Section 195 of the old Judicial Code as amended,* comprised two elements, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases, and a second authorizing this Court to

* Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 617 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

review such decisions. It did not refer to patent or trademark matters. The codification of Title 28 merely separated the foregoing two provisions, placing the former in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256.[3] Nothing in the codifying Act of 1948 or in its history suggests that Congress had any intention of giving this Court the power to review a class of cases over which jurisdiction had previously been withheld.

2. There is no merit to petitioner's contention that the Patent Office arbitrarily refused to accept his word that construction of a 2 m.c. saw-tooth generator was possible by one "skilled in the art" and unreasonably determined that he had made an insufficient disclosure of the generator. The burden of proof is always upon the applicant to show the patentability of his alleged invention. *Durham* v. *Seymour*, 6 App. D. C. 78, appeal dismissed, 161 U.S. 235; *Application of Aller*, 220 F. 2d 454 (C.C.P.A.). This burden was not discharged by the conclusory statement made by petitioner in an affidavit that a person skilled in the art could carry out the particular construction. Cf. *In re Swenson*, 132 F. 2d 1020 (C.C.P.A.); *International Standard Electric Corp.* v. *Marzall*, 184 F. 2d 592, 593 (C.A.D.C.).

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[3] The Reviser's Notes to Sections 1256 and 1541 confirm this derivation of those provisions.

The objects of the statutory requirement of disclosure are to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent and to inform the public during the life of the patent of the monopoly asserted, so that interested people will know which features may be safely used or manufactured without a license and which may not. *Schriber Co.* v. *Cleveland Trust Co.*, 305 U.S. 47, 57. Therefore, a party claiming an invention must make a sufficient disclosure to enable any person skilled in the art to practice the invention without further research or exercise of inventive skill. *Standard Brands, Inc.* v. *National Grain Yeast Corp.*, 308 U.S. 34, 38; *Standard Oil Co.* v. *Tide Water Associated Oil Co.*, 154 F. 2d 579, 583 (C.A. 3); *Application of Beach*, 152 F. 2d 981, 983 (C.C.P.A.).

Here, however, petitioner stated (Pet. 3a) only that it was "well within the competence and knowledge of the average electronics engineer working within the fields of television and radar to design saw-tooth oscillators operable at the [2 m.c.] frequency" utilizing the constructions indicated in materials submitted by his attorney. But, as the court below noted (*ibid.*), the material referred to by petitioner disclosed "a 100 kilocycle saw-tooth wave generator, which is one-twentieth the frequency of what * * * [petitioner's] specification calls for as a minimum." And, as the court further observed (Pet. 4a), although saw-tooth generators were previously known in the art, the applicable literature disclosed that "such oscillators or generators *operable at 2 m.c.*,

in such equipment as applicant's, were not known." (Emphasis in original) In the absence of such prior knowledge it was, as the court below properly held, incumbent upon petitioner to supply the information which would establish that the generator would operate at the claimed frequency. The lack of such prior knowledge in the art and petitioner's refusal or inability to supply it, rendered petitioner's application nothing more than an invitation to experiment. That is a "fatal flaw" in the application. *Standard Brands, Inc.* v. *National Grain Yeast Corp.*, 308 U.S. 34, 38; *Standard Oil Co.* v. *Tide Water Associated Oil Co.*, 154 F. 2d 579, 583 (C.A. 3).

In re Chilowsky, 229 F. 2d 457 (C.C.P.A.), relied upon by petitioner (Pet. 21-22), is not to the contrary. Objectionable indefiniteness must be determined on the basis of the facts in each case. *Chicago Pneumatic Tool Co.* v. *Hughes Tool Co.*, 97 F. 2d 945, 948 (C.A. 10), certiorari denied, 305 U.S. 643. Moreover, the *Chilowsky* case merely held (229 F.2d at 462) that a broad allegation by the Examiner and the Board "that the application disclosure is speculative, coupled with a recitation of various difficulties which might be encountered in attempting to put it into practice, and a further assertion that there might be still other difficulties which could not be foreseen," did not constitute "a sufficiently definite statement of a basis for rejection." In the instant case, however, the court below (Pet. 5a-6a) pinpointed the defect in the application: "If [petitioner] was not in a position to take one of the four very simple circuit diagrams cited, showing lower frequency (100

k.c.) generators, and supply the component values (parameters) which would make it operate at the required frequency of 2 m.c. or higher, then he had not completed his invention."

CONCLUSION

For the reasons stated, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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